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EXAMINER

MARSCHEL, A

ART UNIT

PAPER NUMBER

23

1807

DATE MAILED:

12/03/91

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

9/6/91 (Amdt)

This application has been examined  Responsive to communication filed on 10/6/91 (Supl. Amdt)  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 day(s) from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, Form PTO-152
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1.  Claims 14, 26, 29, 40, 41, and 44-60 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims 12, 13, 16-25, 27, 28, 30, 33-39, 42, and 43 have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 14, 26, 29, 40, 41, and 44-60 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

EXAMINER'S ACTION

The Group and/or Art Unit location of your application to the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1800, Art Unit 1807.

Applicants' Amendment filed 9/6/91 and applicant's Supplemental Amendment filed 11/6/91 have been fully considered and they are deemed to be persuasive to overcome the previously applied rejections. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

It is acknowledged that applicants have copied claims and proposed a count along with a request for an interference. The potential declaration of an interference will be deferred until such time as allowable subject matter is indicated in the instant application.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

Claims 14, 26, 28, 40, 41, and 44-60 are rejected under 35 U.S.C. § 101 because the instant disclosure lacks both the necessary diagnostic and prognostic data to support the claimed diagnostic and prognostic utility. It is noted that several statements are given in specification as to the value of the

instant invention with regard to said utility. Due to the well known unpredictability of cancer diagnosis and prognosis, clear clinical data is required to support said utility. Additionally, the instantly disclosed cell line data is insufficient to support in vivo diagnostic and prognostic utility. See MPEP 608.01(p), part A, subsection directed to 35 U.S.C. 101.

Claims 14, 26, 29, 40, 41, and 44-60 are allowable over the prior art of record. The Examiner suggests that nucleic acids having the disclosed sequence may be allowable subject matter.

No claim is allowed.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

The CMI Fax Center number is (703) 308-4227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December 2, 1991

*Ardin Marschel*  
ARDIN MARSCHEL  
PATENT EXAMINER  
ART UNIT 1807